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09/728,152

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Michael H. Gilbert

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03/24/2009

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EXAMINER

KARMIS, STEFANOS

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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4 UNITED STATES PATENT AND TRADEMARK OFFICE  
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6  
7 BEFORE THE BOARD OF PATENT APPEALS  
8 AND INTERFERENCES  
9

10  
11 *Ex parte* MICHAEL H. GILBERT  
12

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14 Appeal 2009-0323  
15 Application 09/728,152  
16 Technology Center 3600  
17

18  
19 Decided: <sup>1</sup>March 24, 2009  
20

21  
22 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and DAVID B.  
23 WALKER, *Administrative Patent Judges*.  
24 FETTING, *Administrative Patent Judge*.

25 DECISION ON APPEAL  
26

27 STATEMENT OF THE CASE

28 Michael H. Gilbert (Appellant) seeks review under 35 U.S.C. § 134 of a final  
29 rejection of claims 1-18, the only claims pending in the application on appeal.

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<sup>1</sup> The two month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

2  
3 We AFFIRM-IN-PART and ENTER A NEW GROUND OF REJECTION  
4 PURSUANT TO 37 C.F.R §41.50(b).

5 The Appellant invented a billing and payment processing system (Specification  
6 Page 1, lines 2-5).

7 An understanding of the invention can be derived from a reading of exemplary  
8 claims 1, 6, and 7, which are reproduced below [bracketed matter and some  
9 paragraphing added].

10 1. A method of generating and processing billing and payment  
11 information utilizing computing units connected to a network for a  
12 service provided cooperatively by multiple tiers, the method  
13 comprising the steps of:

14 [1] collecting by a first computer unit usage information by a direct  
15 feed of raw data of the service from a meter by a customer from one  
16 of a first tier of the multiple tiers or a third party;

17 [2] integrating by a second computer unit the usage information  
18 with customer profile information of the customer provided by a  
19 second tier of the multiple tiers;

20 [3] generating by a third computer unit billing information based  
21 on the usage information, the customer profile information, and rate  
22 information for the service; and

23 [4] transmitting by a fourth computer unit a bill, based on the  
24 billing information to the customer.

25  
26 6. The method according to claim 5, wherein the step of transmitting  
27 the bill to the customer includes the steps of: printing the bill at an  
28 optimal mailing location based on address information of the  
29 customer; and mailing the bill from the optimal mailing location.

7. The method according to claim 6, wherein the optimal mailing location is determined based on at least one of a zip-code of the customer, a transportation cost, an environmental impact, or a mailing capacity of a mail distribution center.

This appeal arises from the Examiner's final Rejection, mailed August 9, 2007. The Appellant filed an Appeal Brief in support of the appeal on January 4, 2008. An Examiner's Answer to the Appeal Brief was mailed on March 13, 2008.

## PRIOR ART

The Examiner relies upon the following prior art:

Savage et al. US 2002/0023694 A1 February 28, 2002

Carlin et al. US 6,697,843 B1 February 24, 2004<sup>2</sup>

## REJECTIONS

Claims 1-5 and 8-18 stand rejected under 35 U.S.C. §102(e) as anticipated by Savage.

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as unpatentable over Savage and Carlin.

<sup>2</sup> The Examiner's Answer lists Gilbert (US 2002/0069163) as a reference cited, however, Carlin is used in the actual rejection.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1-5 and 8-18 under 35 U.S.C. §102(e) as anticipated by Savage.
  - The pertinent issue turns on whether Savage describes a direct feed of raw data from a meter of a customer to the provider.
- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 6 and 7 under 35 U.S.C. §103(a) as unpatentable over Savage and Carlin.
  - The pertinent issue turns on whether Carlin describes determining an optimal mail production facility based on the zip code of the customer.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Savage*

01. Savage is directed to a system and method for creating combined billing statements for customers of multiple vendors on a single periodic statement (paragraph 0001).
02. Savage is concerned with decreasing the number of resources required for services by automating processes (paragraphs 0009 and 00023).

1           03. The billing system supports the processes of marketing, customer  
2           care, bill calculation, retail company bill aggregation, statement  
3           generation, receivables management, and settlements (paragraph 0061).

4           04. The customer information system maintains customer profile  
5           information. The customer profile information includes a transaction  
6           history of all of the goods and services purchased by the customer  
7           (paragraph 0076). The customer is associated with the supplier's  
8           information in the bill calculation system (paragraph 0094).

9           05. The usage database compiles energy usage data and creates and sends  
10          a flat file of usage and meter detail to the bill calculator (paragraph  
11          0094). The bill calculation module receives usage data. For example,  
12          raw energy usage in kilowatt hour for used electricity or gas is received  
13          from an energy vendor and placed on the bill. The bill calculation  
14          module converts the usage data into a rated bill (paragraph 0098). Bill  
15          calculation by computer systems 114 of financial institution 100  
16          involves receiving and validating energy usage data feed, for example,  
17          from a vendor 140, such as energy retailer 104 shown in FIG. 1,  
18          automatically calculating charges and taxes based on the energy pricing  
19          parameters of the energy retailer 104, and generating usage, accounting,  
20          and settlement reports to the energy retailer 104 (paragraph 0055).

21          06. The system collects all charges associated to the customer and  
22          aggregates them on to a single bill. The bill is delivered to the customer  
23          in the customer's desired format. The bill format is available in both  
24          paper and electronic forms (paragraph 0110).

1           07. If energy usage is in dispute, a meter re-read request is submitted to a  
2           vendor technician who re-reads the customer's meter and logs the re-  
3           read data in to the wires and pipes database (paragraph 0088).

4  
5           *Carlin*

6           08. Carlin is directed to a system and method for distributed hybrid mail  
7           (column 1, lines 7-10).

8           09. Mail production facilities merge fixed and variable information to  
9           create fully integrated mail. The integrated mail image is printed and  
10          distributed (column 5, lines 17-29).

11          10. Mailing data is sorted based on zip code information. Mail production  
12          facilities print mail based on the nearest proximity to the listed zip code  
13          (column 4, lines 52-65). This sorting by zip code enables taking  
14          advantage of postage discounts and processing efficiencies (column 3,  
15          lines 53-63).

16          *Facts Related To The Level Of Skill In The Art*

17          11. Neither the Examiner nor the Appellant has addressed the level of  
18          ordinary skill in the pertinent art billing and payment processing. We  
19          will therefore consider the cited prior art as representative of the level of  
20          ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355  
21          (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill  
22          in the art does not give rise to reversible error ‘where the prior art itself  
23          reflects an appropriate level and a need for testimony is not shown’”)

(quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

*Facts Related To Secondary Considerations*

12. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

*Anticipation*

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

*Obviousness*

A claimed invention is unpatentable if the differences between it and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (2000); *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).



1 In *Graham*, the Court held that that the obviousness analysis is bottomed on  
2 several basic factual inquiries: “[ (1) ] the scope and content of the prior art are to be  
3 determined; [ (2) ] differences between the prior art and the claims at issue are to be  
4 ascertained; and [ (3) ] the level of ordinary skill in the pertinent art resolved.” 383  
5 U.S. at 17. See also *KSR*, 127 S.Ct. at 1734. “The combination of familiar  
6 elements according to known methods is likely to be obvious when it does no more  
7 than yield predictable results.” *Id.* at 1739.

8 “When a work is available in one field of endeavor, design incentives and  
9 other market forces can prompt variations of it, either in the same field or a  
10 different one. If a person of ordinary skill can implement a predictable variation, §  
11 103 likely bars its patentability.” *Id.* at 1740.

12 “For the same reason, if a technique has been used to improve one device,  
13 and a person of ordinary skill in the art would recognize that it would improve  
14 similar devices in the same way, using the technique is obvious unless its actual  
15 application is beyond his or her skill.” *Id.*

16 “Under the correct analysis, any need or problem known in the field of  
17 endeavor at the time of invention and addressed by the patent can provide a reason  
18 for combining the elements in the manner claimed.” *Id.* at 1742.

19 *Automation of a Known Process*

20 It is generally obvious to automate a known manual procedure or mechanical  
21 device. Our reviewing court stated in *Leapfrog Enterprises Inc. v. Fisher-Price*  
22 *Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary skill in the art would have  
23 found it obvious to combine an old electromechanical device with electronic  
24 circuitry “to update it using modern electronic components in order to gain the  
25 commonly understood benefits of such adaptation, such as decreased size,

1 increased reliability, simplified operation, and reduced cost. . . . The combination  
2 is thus the adaptation of an old idea or invention . . . using newer technology that is  
3 commonly available and understood in the art.” *Id* at 1163.

4 ANALYSIS

5 *Claims 1-5 and 8-18 rejected under 35 U.S.C. §102(e) as anticipated by*  
6 *Savage*

7 The Appellant argues these claims as a group.

8 Accordingly, we select claim 1 as representative of the group.  
9 37 C.F.R. § 41.37(c)(1)(vii) (2007).

10 The Examiner found that Savage described all of the limitations of claim 1 and  
11 thus anticipates claim 1 (Answer Pages 3-4). The Appellant contends that Savage  
12 fails to describe limitation [1] of claim 1 (Br. Page 10, second paragraph). We  
13 agree with the Appellant. First, the Appellant does not contest limitations [2] – [4],  
14 and we find these limitations are described by Savage (FF 04, FF 05, and FF 06).

15 Limitation [1] requires in part a direct feed *from a meter* of a customer’s raw  
16 usage data. Savage describes a customer’s meter is read and submitted to the  
17 provider as raw data such as kilowatt hours (FF 05). The energy usage data feed is  
18 further validated (FF 05). Savage describes that a vendor technician reads the  
19 meter at re-read requests (FF 07), however, Savage is silent as to how the meter is  
20 otherwise read during the normal course of business. As such, we find no evidence  
21 that Savage describes a direct feed from a meter as required by limitation [1] of  
22 claim 1.

1 The Appellant has sustained its burden of showing that the Examiner erred in  
2 rejecting claims 1-5 and 8-16 under 35 U.S.C. § 102(e) as anticipated by Savage  
3 for the above reasons.

4 NEW GROUND OF REJECTION

5 The following new ground of rejection is entered pursuant to  
6 37 C.F.R. § 41.50(b). Claims 1-5 and 8-16 are rejected under 35 U.S.C. § 103(a)  
7 as unpatentable over Savage.

8 Savage describes all of the limitations of claim 1, as we found *supra*, except for  
9 the limitation of the meter reading being directly fed to the first computer. Savage  
10 describes that when a bill is in dispute, this step is manually performed by a vendor  
11 technician, i.e. a vendor technician reads the meter and logs the results (FF 07).  
12 Savage is silent as to how this step occurs in the initial reading. It is generally  
13 obvious to automate a known manual procedure or mechanical device. *Leapfrog*  
14 *Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007). That is, one  
15 of ordinary skill knew both the benefits of and the implementation requirements of  
16 automating the feed of the meter data to a computer system. The meter is itself a  
17 disclosed instance of automation by which energy usage data is directly fed into  
18 the meter. Savage describes the feeding of data among computer systems. The  
19 only issue is whether applying such data feeds to the initial data entry from the  
20 meter would have been predictable to one of ordinary skill. Our reviewing court  
21 held in *Leapfrog* at 1163 that simply using newer technology that is commonly  
22 available and understood in the art is predictable and obvious. Thus automating  
23 the step of reading the meter and feeding the data to the provider computer would  
24 have been obvious to one of ordinary skill in the art at the time the invention was  
25 made.

1 Further, Savage is concerned with the decreasing of costs associated with  
2 additional resources for performing manual steps by automating these processes  
3 (FF 02). So, additionally, one of ordinary skill in the art would have been  
4 motivated to modify Savage to automate the raw data feed from the meter to the  
5 provider in order to decrease the costs associated with the additional resources  
6 required to perform the manual steps.

7 As to the remaining claims 2-5 and 8-16, none of the Examiner's findings  
8 regarding their additional limitations are contested and we accordingly adopt the  
9 Examiner's findings as to how Savage describes those limitations.

10 *Claims 6 and 7 rejected under 35 U.S.C. §103(a) as unpatentable over Savage*  
11 *and Carlin*

12 Claim 6 requires printing the bill at an optimal mailing location based on  
13 address information of the customer and mailing the bill from the optimal mailing  
14 location. Claim 7 requires that the optimal mailing location be determined using at  
15 least one of several factors, including that of the zip code of the customer.

16 The Examiner found that Savage describes all of the limitations of claim 1 and  
17 the additional limitation in claim 6 of "mailing the bill from the optimal location"  
18 (Answer Page 7). The Examiner found that Savage failed to describe the limitation  
19 of "printing the bill" of claim 6 and "the optimal mailing location based on the  
20 address, transportation cost, environmental impact or mail capacity of a distributor  
21 and mailing the bill to the customer" of claim 7 (Answer Page 7). The Examiner  
22 found that Carlin taught these limitations and that one of ordinary skill in the art  
23 would have found it obvious to combine Carlin and Savage to include these  
24 features in order to increase the speed and lower the cost of bill delivery (Answer  
25 Page 7).

1 The Appellant contends that (1) Carlin fails to describe the optimal mailing  
2 production facility location of claim 6 (Br. Page 12, first paragraph) and (2) the  
3 cited art fails to describe claim 7 (Answer Page 13, second paragraph).

4 The Appellant has made no argument regarding the Examiner's findings, but  
5 has only recited the limitations in claims 6 and 7 and made a general allegation that  
6 they are not described by the art. The Appellant's arguments with respect to these  
7 claims simply state, in whole or in part, that the references do not disclose or  
8 suggest certain claimed features – without responding to the Examiner's reasoning  
9 in establishing a prima facie case of obviousness. A general allegation that the art  
10 does not teach any of the claim limitations is no more than merely pointing out the  
11 claim limitations. A statement which merely points out what a claim recites will  
12 not be considered an argument for separate patentability of the claim. 37 C.F.R. §  
13 41.37(c)(1)(vii).

14 Nevertheless, we find that Carlin describes how mail is generated at the  
15 appropriately located mail production facilities determined by the zip code of the  
16 customer (FF 10). Carlin is directly concerned with the optimal location for mail  
17 production facilities to take advantage of postage discounts and processing  
18 efficiencies (FF 10). Also, Carlin describes determining the optimal mailing  
19 location by the zip code of the customer (FF 10). As such, Carlin does describe the  
20 printing, determining, and mailing regarding the optimal mailing production  
21 facility location of claims 6 and 7.

22 The Appellant has not sustained his burden of showing that the Examiner erred  
23 in rejecting claims 6-7 under 35 U.S.C. § 103(a) as unpatentable over Savage and  
24 Carlin for the above reasons. Claims 6 and 7 depend from claim 1, however, and

claim 1 is now rejected under a new ground. Accordingly, we will denominate the rejection of claims 6 and 7 as a new ground.

#### CONCLUSIONS OF LAW

The Appellant has sustained its burden of showing that the Examiner erred in rejecting claims under 35 U.S.C. § 102(e) as anticipated over Savage.

A new ground of rejection is entered 37 C.F.R. § 41.50(b) and claims 1-5 and 8-16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Savage.

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 6-7 under 35 U.S.C. § 103(a) as unpatentable over Savage and Carlin in light of the new ground of rejection.

#### DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-5 and 8-16 under 35 U.S.C. § 102(e) as anticipated by Savage is not sustained.
- A new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b).
  - Claims 1-5 and 8-16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Savage.
- The rejection of claims 6-7 under 35 U.S.C. § 103(a) as unpatentable over Savage and Carlin is sustained.
  - This rejection of claims 6-7 is denominated as a new ground of rejection.

1 Our decision is not a final agency action.

2 In addition to affirming the Examiner's rejection(s) of one or more claims, this  
3 decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37  
4 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph  
5 shall not be considered final for judicial review.” This Decision contains a new  
6 rejection within the meaning of 37 C.F.R. § 41.50(b) (2007).

7 37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS  
8 FROM THE DATE OF THE DECISION, must exercise one of the following two  
9 options with respect to the new rejection:

10 (1) Reopen prosecution. Submit an appropriate amendment of the  
11 claims so rejected or new evidence relating to the claims so  
12 rejected, or both, and have the matter reconsidered by the  
13 Examiner, in which event the proceeding will be remanded to the  
14 Examiner. . . .

15 (2) Request rehearing. Request that the proceeding be reheard under §  
16 41.52 by the Board upon the same record. . . .

17 Should the Appellant elect to prosecute further before the examiner pursuant to  
18 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35  
19 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of  
20 the affirmance is deferred until conclusion of the prosecution before the Examiner  
21 unless, as a mere incident to the limited prosecution, the affirmed rejection is  
22 overcome.

23 If the Appellant elects prosecution before the Examiner and this does not  
24 result in allowance of the application, abandonment or a second appeal, this case  
25 should be returned to the Board of Patent Appeals and Interferences for final action  
26 on the affirmed rejection, including any timely request for rehearing thereof.

1 No time period for taking any subsequent action in connection with this appeal  
2 may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv)  
3 (2007).

4  
5 AFFIRMED-IN-PART

6 41.50(b)  
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